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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,167	04/12/2001	Paul K. Kavanaugh	42270/PY1/X3	4504

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EXAMINER

PARK, ILWOO

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 07/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/834,167

Applicant(s)

KAVANAUGH ET AL.

Examiner

Ilwoo Park

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,7-16 and 29-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,7-16 and 29-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/20/02 has been entered.
2. Applicant's amendment filed on 5/20/02 in response to Examiner's Office Action has been reviewed. Claims 5 and 6 are canceled and claims 1, 2, 8, 12, 15, 29, 30, 33, 36, and 40 are amended. The following rejections now apply.
3. Claims 1-4, 7-16, and 29-40 are presented for examination.
4. Steere, Jr. et al., Gee et al., and Ohdake et al. were cited as prior art in the last office action.

### *Claim Rejections - 35 USC § 112*

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 33 and 34 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one

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skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As described in the claim 33 itself and page 29, line 16-page 30, line 3 of the specification, a touch-sensitive display device outputs a display; thus, the touch-sensitive display device may be an input device or an input/output device and is not an exclusive input device.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 © of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1, 7-10, 12, 16, 29, 35-38, and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Chou, US patent No. 6,154,759.

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As to claim 1, Chou teaches a wallet [VCC wallet 2 in fig. 1] for use with a personal information device [col. 3, lines 29-32], said wallet comprising:

a first portion [ref. No. 21 in fig. 2] integrally including an exclusive input device [mini input keyboard 3; col. 3, lines 12-13] for receiving a user-supplied input, wherein the exclusive input device is only for receiving the user-supplied input, and the exclusive input device is integrated with the first portion of the wallet; and

a second portion [ref. No. 20 in fig. 2] rotatably coupled to said first portion, said second portion to receive and detachably retain a personal information device [col. 3, lines 3-12] in the form of a PCMCIA card [col. 4, lines 58-64], said second portion including supply means electrically coupled [col. 3, lines 13-15] to said exclusive input device and being adapted to supply a signal representing said user-supplied input said personal information device.

9. As to claim 7, Chou teaches said supply means is a PCMCIA port [col. 4, lines 58-64] adapted to be coupled to a PCMCIA I/O port of said personal information device when said wallet receives said personal information device.

10. As to claims 8 and 36, Chou teaches said first and second portions represent first and second halves, respectively, and are adapted to be held in an open position [col. 3, lines 3-11] in which a display [screen 11 in fig. 1] of said personal information device and said exclusive input device of said wallet both accessible to the user, and are adapted to be folded together wherein respective faces of said first and second halves face each other defining a closed position; and

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wherein neither said display of said personal information device nor said exclusive input device of said wallet is accessible to said user in said closed position.

11. As to claims 9, 16, and 37, Chou teaches one of said first and second portions further includes an I/O connector [ref. No. 31 in fig. 2] adapted to be coupled via a cable to an external device, said I/O connector being electrically connected to said supply means and being adapted to provide data supplied from said external device to said supply means, and said supply means is adapted to supply said data supplied thereto including data supplied from external device to said personal information device [col. 3, lines 21-28; col. 3, lines 42-49].

12. As to claims 10 and 38, Chou teaches said external device is a computer [col. 3, lines 42-49].

13. As to claim 12, Chou teaches a wallet [VCC wallet 2 in fig. 1] in combination with a personal information device [col. 3, lines 29-32], the combination comprising:

a wallet first portion [ref. No. 21 in fig. 2] including an exclusive input device [mini input keyboard 3; col. 3, lines 12-13] for receiving user-supplied input, wherein the exclusive input device is only for receiving the user-supplied input, and the exclusive input device is integrated with the wallet first portion;

a wallet second portion [ref. No. 20 in fig. 2] rotatably coupled to said first portion, said wallet second portion to receive and detachably retain a PCMCIA card [col. 3, lines 3-12; col. 4, lines 58-64], said wallet second portion including output means for providing [col. 3, lines 13-15] said user-supplied input as an output;

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a personal information device [col. 3, lines 3-12; col. 4, lines 58-64] in the form of a PCMCIA card, said personal information device detachably retained in said wallet second portion, said personal information device including:

a display [screen 11 in fig. 1] for displaying information to the user;

an input device [searching keyboard 12 in fig. 1; col. 3, lines 32-37] for receiving additional user-supplied input; and

input means for receiving [col. 3, lines 13-15] data from said output means of said wallet second portion when said personal information device is retained in said wallet first portion.

14. As to claims 29 and 35, Chou teaches a wallet [VCC wallet 2 in fig. 1] for use with a personal information device [col. 3, lines 29-32], said wallet comprising:

a first portion [ref. No. 21 in fig. 2] including an integrated exclusive input device [mini input keyboard 3; col. 3, lines 12-13] only for receiving user-supplied input; and

a second portion [ref. No. 20 in fig. 2] rotatably coupled to said first portion, said second portion being adapted to receive and detachably retain a personal information device [col. 3, lines 3-12] in the form of a PCMCIA card [col. 4, lines 58-64], said second portion including an interface electrically coupled [col. 3, lines 13-15] to said exclusive input device and being adapted to communicate with said information device.

15. As to claim 40, Chou teaches said interface is adapted to supply a signal representing said user-supplied input to said information device [col. 3, lines 13-15].

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*Claim Rejections - 35 USC § 103*

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 2, 15, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chou as applied to claims 1, 12, and 29 above, and further in view of Moissev et al., US patent No. 5,945,980.

As to claims 2, 15, and 30, Chou teaches the exclusive input device is in the form of a keyboard. However, Chow does not expressly disclose the exclusive input device is a touch pad. Moissev et al teach [col. 1, lines 9-12] an exclusive input device is a touch pad in the form of a keyboard. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the keyboard of Chow into a touch pad keyboard because it would increase reliability of Chow's portable wallet.

18. Claims 3, 11, 13, 31, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chow as applied to claims 1, 9, 12, 29, and 37 above, and further in view of Gee et al., US patent No. 5,619,396.



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As to claims 3, 13, and 31, Chow teaches electrical contacts. However, Chow does not disclose the electrical contacts adapted to contact opposing surfaces on said personal information device when retained by said wallet.

Gee et al teach electrical contacts for detachably retaining a PCMCIA card. Specifically, Gee et al teach the electrical contacts [ref. Nos. 26 and 28] adapted to contact opposing surfaces on said PCMCIA card when retained by said wallet.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Chow and Gee et al because they both teach electrical contacts for detachably retaining a PCMCIA card and Gee et al's teaching of the electrical contacts adapted to contact opposing surfaces on said personal information device when retained by said wallet would reduce size of Chow's portable wallet.

As to claims 11 and 39, Gee et al teach a wallet [col. 2, lines 1-2] having an I/O connector [col. 2, lines 58-60] adapted to be coupled via a cable [col. 2, lines 64-67] to another wallet [PCMCIA add on member 24] so that communication between two coupled PCMCIA cards is possible.

19. Claims 4, 14, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chow as applied to claims 1, 12, and 29 above, and further in view of Ohdake et al., US patent No. 5,594,680.

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As to claims 4, 14, and 32, Ohdake et al teach an induction coil for communication without electrical contact [abstract] for interfacing a PCMCIA card [col. 8, lines 1-5].

Therefore, it would have been obvious to one skilled in the art at the time of the invention was made to combine the teachings of Chow and Ohdake because they both teach interfacing a PCMCIA card and the Ohdake's teaching of an induction coil for communication without electrical contact would increase reliability of Chow's communication with the PCMCIA card.

### *Conclusion*

20. Any inquiry concerning this communication should be directed to Ilwoo Park, whose telephone number is (703) 308-7811 or via e-mail, *ilwoo.park@uspto.gov*. The Examiner can normally be reached Monday through Friday from 9:00 AM to 5:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Jeffrey A. Gaffin, can be reached at (703) 308-3301.

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 746-7239 (for formal communications intended for entry),

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(703) 746-7238 (for after-final communications),

**or:**

(703) 746-7240 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., 4th Floor (Receptionist)

*Ilwoo Park*  
Ilwoo Park

June 26, 2002